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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/472,666	12/27/1999	KEITH C. THOMAS	98-1176	9062

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EXAMINER	
ALVAREZ, RAQUEL	
ART UNIT	**PAPER NUMBER**
3622	

DATE MAILED: 10/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/472,666	THOMAS, KEITH C.	
	Examiner	Art Unit	
	Raquel Alvarez	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 June 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *19,20,22-39 and 55-66* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *19,20,22-39,55-66* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.1 14

1. A request for continued examination under 37 CFR 1 .114, including the fee set forth in 37 CFR 1 .17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1 .1 14, and the fee set forth in 37 CFR 1 .17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1 .1 14. Applicant's submission filed on June 24,2004 has been entered.

Specification

2. The amendment to the specification has not be entered because it raises new matter. See 37 CFR 1.121(f) and MPEP § 608.04.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 19-20, 22-39 and 55-66 rejected under 35 U.S.C. 103(a) as being unpatentable over Ebisawa (5,946,664 hereinafter Ebisawa) in view of Margulis (5,946,664 hereinafter Margulis).

With respect to claims 19-39 and 55-65, Ebisawa teaches a removable moving media comprising: a source content (video game); a removable content disposed within

the source content (col. 3, lines 58-60), a communication assembly in connection with a virtual product source providing access to the source content and the removable content (col. 3, lines 20-35, col. 5, lines 12-21, 30-35, col. 6, lines 10-20, 35-38, col. 6, line 50- col. 8, line 25)., wherein the communication assembly allows the visual product source to place a virtual product within the removable moving media through utilization of the removable content disposed within the source content (col. 3, lines 58-60). Ebisawa also teaches a method for placement of visual product in a moving media, comprising selecting an original source media including a removable content, the removable content providing a visual product location (col. 3, lines 20-35, 01. 5, lines 12-20, 01. 7, lines 30-67),receiving a virtual product content from a peripheral visual product source (col. 7, lines 1-10, 30-67, col. 5, lines 12-20, col. 6, lines 12-19, lines 35-38)., editing the original source media and inserting the visual product content in the visual product location of the original source media (col. 3, lines 50-60, col. 7, lines 10-25). Ebisawa also teaches a system for placing virtual products within a moving media comprising an original moving media content source including a removable content, the removable content providing a visual product location (col. 3, lines 20-35),. a network in communication with the original moving media content source, the network providing a visual product source (figs, 7-9 and related text, col. 5, lines 12-20), a visual product disposed within the virtual product source, the visual product being enabled for placement in the virtual product location of the removable content (advertisements described; wherein the visual product is downloaded from the network and placed on the moving media in the virtual product location (col. 5, lines 12-20, lines 60-65, col. 3,

lines 20-35, 55-60).

Ebisawa also teaches the visual product source is at least one of a network and a peripheral computing system (col. 3, lines 60-65, col. 5, lines 12-20, figs. 7-9 and related text; the virtual product source updates the visual product location on the removable content within the source content (col. 5, lines 35-50)', the source content is a video game (col. 1, lines 15-20) wherein the source content is at least on of a streaming video or video stream and a video file format (col. 7, lines 12-20, 50-60), the source content is a digital source content (col. 5, line 60 - col. 6, line 20). In this case, a virtual product refers to any object which is replaced or replaces in a scene for the purposes of providing advertising. To the extent that the claim to a visual product may be interpreted differently, it would have been obvious to one having ordinary skill in the art at the time of the invention to have used a virtual product in Ebisawa since product placement is well known in the art for product exposure and advertisement purposes and would have been adopted for the intended use of the artistic choices of the game manufacturer and sponsors). It also would have been obvious to have the virtual product placed within the moving media through a paint process since this would have been adopted for the intended use of providing static advertisements such as on the billboard of Ebisawa.

Ebisawa substantially teaches the invention as described above, but does not show a visual product is a commercial item associated with a brand identity or the commercial product comprises packaging containing a consumable product or a can of beer. Margulis teaches replacement of objects including a commercial item associated

with a brand identity or the commercial product comprises packaging containing a consumable product (col. 16, line 59 - col. 17, line 5). It would have been obvious to one having ordinary skill in the art at the time of the invention to have inserted/replaced an object in Ebisawa as in Margulis since the objects of Margulis are used as advertisements and would have been adopted for the intended use of updated advertising. It also would have been obvious to have the commercial item as a can of beer since this would have been adopted for the intended use of a beer manufacturer advertising campaign.

With respect to claim 66, in addition to the limitations addressed above it further teaches the source content adhering to an MPEG-4 format. Official notice is taken that is old and well known in the computer related files for files to adhere to a MPEG-4 format because such a modification would provide a much smaller format without sacrificing quality. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included the source content adhering to an MPEG-4 format in order to obtain the above mentioned advantage.

Response to Arguments

4. With respect to the virtual products being commercial items and updating the location of the virtual products. The Examiner wants to point out that claims were rejected under the doctrine of 103. Ebisawa teaches the claimed invention with the exception of the products being commercial items and updating the location of the

products. On the other hand, Margulis teaches an "Apparatus and method for performing image transforms in a digital display system" (title), Margulis teaches transformation of the display to accurately portray the input images (col. 5, lines 28-31). In addition Margulis teaches "Replacement of one object with another object in the video stream, which can be used for placement of products as advertisement" and changing the an image of a can of soda displaying a label of either Coke or Pepsi, it allows the desired label to be superimposed on the soda can (col. 16, line 59 - col. 17, line 5).

5. The Amendment to the specification will not be entered because it raises new matter. The Examiner maintains that the virtual product source is a network or a website is not shown in the specification.

6. In light of the above, it is the Examiner's position that Ebisawa in combination with Margulis teach the claimed invention.

Conclusion

7. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1 .114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1 .1 14. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Point of contact

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (703)305-0456. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric w Stamber can be reached on (703)305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Raquel Alvarez
Primary Examiner
Art Unit 3622

R.A.
10/25/04